REMARKS

The Office Action dated May 19, 2006, has been received and carefully noted. The amendments made herein and the following remarks are submitted as a full and complete response thereto. Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claims 5, 7, and 8 have been amended. Claims 1-4 and 6 were previously withdrawn. Thus, claims 5, 7, and 8 are currently pending in the application and subject to examination.

In the Office Action mailed May 19, 2006, the Examiner rejected claim 7 under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 7 has been amended responsive to this rejection. If any additional amendment is necessary to overcome this rejection, the Examiner is requested to contact the Applicant's undersigned representative.

The Examiner rejected claims 5 and 8 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,679,353 to Parmenter et al. ("Parmenter"). The Examiner rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Parmenter in view of U.S. Patent No. 5,533,072 to Georgiou et al. ("Georgiou"). The Applicants note that claims 5, 7, and 8 have been amended. To the extent that the rejections remain applicable to the claims currently pending, the Applicants respectfully traverse the rejections as follows.

Applicants invention as now set forth in amended claim 5 is directed to a method for controlling a clock switching circuit including, in part, inhibiting outputting the basic

clock signal upon a connection of an interface cable which transmits a high speed signal.

Parmenter teaches a clock switching method, switching between a basic and PLL clock signal where the method includes waiting until the next clock phase boundary to switch the clocks. However, Parmenter does not disclose or suggest at least inhibiting outputting the basic clock signal upon a connection of an interface cable which transmits a high speed signal.

The amendment to claim 5 adds a limitation similar to that in previous claim 7, which the Examiner admits is not disclosed or suggested in Parmenter. The Examiner relies on Georgiou for this limitation. The Examiner asserts that Georgiou's coded input signal is equivalent to an interface cable. The Applicants note that claims 5, 7, and 8 have been amended to recite an interface cable "which transmits a high speed signal."

The Applicants further submit that even if Parmenter and Georgiou were combined, which is not admitted, Georgiou's coded input signal is not equivalent to the claimed interface cable connection as asserted by the Examiner. According to Georgiou, the coded input signal includes unknown phase shift causing the input delay module 22 to generate N delayed input replicas, each of which has different phase delays, and the phase sampling flip-flops 24 and smoothing and selection logic 26 check which delayed input replica is synchronous with the phase of the reference clock. Thus, one of N delayed input replicas with phase synchronous to the reference clock is selected by a multiplexer 28 according to the output select signal from 26.

In contrast, in amended claim 5, when an interface cable that transmits a high speed signal is connected, the clock signal switching circuit switched from the basic clock to the PLL clock to enable the connected interface cable. The connection of the interface cable cannot be expected. Thus, the clock signal switching circuit avoids clock hazard by inhibiting the basic clock, first, counting a predetermined number of the PLL clock signal, and outputting the PLL clock signal thereafter. Georgiou does not disclose or suggest such an interface cable.

For at least this reason, the Applicants submit that claim 5 is allowable over the cited art. For similar reasons, the Applicants submit that claims 7 and 8 are likewise allowable.

With regard to the rejection under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See

also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 5. This is an insufficient showing of motivation.

Conclusion

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with

this communication to Deposit Account No. 01-2300 with reference to attorney docket no. 108066-00018.

Respectfully submitted,

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Enclosure: Petition for Extension of Time (one month)